



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/695,201	08/02/91	HIGUCHI	R 2890

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EXAMINER	
ART UNIT	PAPER NUMBER
1814	20

DATE MAILED:

06/18/93

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 5/24/93 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: None

Claims objected to: _____

Claims rejected: 1-22

However:

- ☒ Applicant's response has overcome the following rejection(s): Claim 11 under 35 USC 112

4. ☒ The affidavit, ~~exhibit~~ ^{and} request for reconsideration has been considered but does not overcome the rejection because see attached
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

_____ drawing correction ☐ has ☐ has not been approved by the examiner.

ROBERT A. WAX
SUPERVISORY PATENT EXAMINER
GROUP 180


Serial Number: 07/695,201

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Art Unit: 1814

After examining the submitted declarations and rereading the Sutherland et al. reference the examiner agrees that Sutherland et al. did not preform the cycling reactions of PCR but this does not render the claims patentable as an examination of the Kaledin et al. reference cited by aplicants shows that one of ordianry skill in the art would not have reasonably expected the levels of EtBr used by Sutherland et al. (1-5 μM , preferably 1.75 μM) to inhibit polymerization at all as Kalledin et al. show in Table 3 that the mininum concentration of EtBr that inhibits *Thermus flavus* DNA polymerase is 5 μM and that half maximal inhibition requires 23 μM EtBr. Furthermore they teach that this is similar to the results found for other known polymerases.

Any inquiry concerning this communication should be directed to Rebecca Prouty at telephone number (703) 308-4000.


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